

<b>PRE-APPEAL BRIEF REQUEST FOR REVIEW</b>		Docket Number <b>Q79778</b>
Mail Stop AF Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450	Application Number <b>10/775,170</b>	Filed <b>February 11, 2004</b>
	First Named Inventor <b>Makoto SUGIZAKI</b>	
	Art Unit <b>2625</b>	Examiner <b>Nathan K. Tyler</b>
<p style="text-align: center;">WASHINGTON OFFICE <b>23373</b> CUSTOMER NUMBER</p>		
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal</p> <p>The review is requested for the reasons(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p><input checked="" type="checkbox"/> I am an attorney or agent of record.</p> <p>Registration number <u>60,645</u></p> <p style="text-align: right;"><u>/Theodore C. Shih/</u> Signature</p> <p style="text-align: right;"><u>Theodore C. Shih</u> Typed or printed name</p> <p style="text-align: right;"><u>(202) 293-7060</u> Telephone number</p> <p style="text-align: right;"><u>November 25, 2008</u> Date</p>		

**PATENT APPLICATION**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of

Docket No: Q79778

Makoto SUGIZAKI

Appln. No.: 10/775,170

Group Art Unit: 2625

Confirmation No.: 1020

Examiner: Nathan K. Tyler

Filed: February 11, 2004

For: HALFTONE DOT CONVERSION APPARATUS, HALFTONE DOT CONVERSION  
PROGRAM STORAGE MEDIUM, AND DOT MATRIX

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

**MAIL STOP AF - PATENTS**

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

Pursuant to the Pre-Appeal Brief Conference Pilot Program, and further to the Examiner's Final Office Action dated May 29, 2008, Applicant files this Pre-Appeal Brief Request for Review. This Request is also accompanied by the filing of a Notice of Appeal.

Applicant turns now to the rejections at issue. As of the Advisory Action mailed October 20, 2008, claims 1, 2, and 4 are rejected under 35 U.S.C. 102(b) as being allegedly anticipated by Kashiwara (US 5,742,317). Claims 8 and 22 are rejected under 35 U.S.C. 103(a) as being allegedly unpatentable over Kashiwara. Claims 28 and 29 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. On November 12, 2008, Applicant contacted the Examiner regarding the status of claim 27. The Examiner stated that claim 27 is rejected but failed to state the basis of the rejection of claim 27.

**Claim 1**

Applicant respectfully submits that claim 1 would not have been anticipated by Kashihara. Claim 1 recites, in part, “halftone dots having sizes according to tone values”. The Examiner asserts:

In response to applicant's arguments, the recitation "halftone dots having sizes according to tone values" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. *See In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Applicant respectfully submits that the Examiner's old cases are not pertinent in view of recent cases that are directly on point. The determination of whether a preamble limits a claim is made on a case-by-case factually or legally basis in light of the facts in each case. Dependence on a preamble recitation to provide antecedent basis for a claim term appearing in the body indicates a reliance on both the preamble and body to define the invention. *Bell Communications Research, Inc. v. Vitalink Communications Corp.*, 55 F.3d 615, 620, 34 USPQ2d 1816, 1820 (Fed. Cir. 1995).

In the present invention, the feature, “halftone dots having sizes according to tone values” is necessary to give life, meaning, and vitality to the “halftone dot conversion section” of claim 1. As recited in claim 1, the “halftone dot conversion apparatus” comprises “a halftone dot conversion section that forms *the halftone dots*” where the antecedent basis for the halftone dots is in the preamble of claim 1. Based on the Federal Circuit precedent, Applicant respectfully

submits that the Examiner must consider “halftone dots having sizes according to tone values” as recited in claim 1.

Furthermore, the Examiner alleges that Kashihara discloses 1. Applicant respectfully submits that this position is not supportable.

The Examiner asserts that the “halftone dots” of the claimed invention is disclosed by the supercell matrix feature of Kashihara. The supercell of Kashihara is disclosed by FIGS. 3 and 4 of Kashihara and col. 10, line 50 of Kashihara, where:

the interpolation circuit 18 refers to the image signals of the peripheral pixels around a target pixel M and converts into signals a, b, c, and d in which the densities in the main scan and sub scan directions are twice as large as those of the image signal for the target pixel M.

The Examiner appears to interpret the supercell as an example of the “halftone dot” of the claimed invention. However, the “halftone dot” of the claimed invention is defined by “having sizes according to the tone values” as recited in claim 1. Therefore, the “halftone dot” of the claimed invention, by its dimensions, may correspond to each halftone dot appearing in a supercell. Assuming *arguendo*, even if the individual halftone dots in the supercell are interconnected and form a group, this group as a whole does not disclose the halftone dot of the claimed invention because the size of the entire group or supercell cannot change according to the tone values. Thus, Kashihara fails to teach or suggest “halftone dots having sizes according to the tone values”.

Because claim 1 is generic to the elected and non-elected species and is allowable for the reasons set forth above, we would request rejoinder of the withdrawn claims.

### **Claim 2**

Applicant respectfully submits that claim 2 would not have been anticipated by Kashihara. The Examiner asserts that, “FIG. 17 shows 4 blank pixels for all 16 tone values ranging 0-15. Kashihara states that the tone values range from 0 to 15 at column 11, line 9” discloses “the halftone dot conversion section always scatters the blanks of the drawing pixels about the halftone dots, at associated positions, respectively, *regardless of the tone values*”. In Kashihara, in the case of an image of *a uniform tone*, the binarized result repeats *the same pattern*. Accordingly, the binarized dither patterns are *varied based on the tone value* and the fill pattern of Kashihara has non-filled blanks in areas that directly depend on the tone value. (See col. 16, lines 12-14 and lines 20-22). Thus, Kashihara fails to teach or suggest “the halftone dot conversion section always scatters the blanks of the drawing pixels about the halftone dots, *at associated positions*, respectively, *regardless of the tone values*” as recited in claim 2 and the teachings of Kashihara are the complete opposite of claim 2.

Claim 27 is merely a more detailed embodiments of how to achieve the scatter *at associated points regardless of tone value*. Therefore, claims 2 and 27 are patentable over the prior art.

### **Claim 8**

Applicant respectfully submits that claim 8 would not have been anticipated by Kashihara. The Examiner contends that Kashihara teaches plural conversion systems. However, each of the fill patterns of FIGS. 6, 17, and 20 relate to *alternative* embodiments. The apparatus of Kashihara would not include multiple fill patterns but, at best, *one* such pattern. The

Examiner may not alter or combine embodiments without a basis to do so. Ex parte Beuthes (71 USPQ2d 1313, 1316, BPAI 2003).

**Claim 22**

For analogous reasons regarding the patentability of claim 1, claim 22 is also patentable over the prior art on rejoinder of all withdrawn claims due to our designation of claims 1 and 22 as generic.

**Claim 27**

Claim 27 recites, in part, “a mask including turn-on points and turn-off points, wherein the turn-on points only permit the drawing pixels and the turn-off points only permit non-drawing pixels”. The Examiner has failed to provide any support or reasoning in the rejection of claim 27. Furthermore, Kashihara fails to teach or suggest any of the above recited claim features of claim 27. Accordingly, claim 27 is patentable over the prior art and Applicant respectfully requests the Examiner to withdraw the rejection of claim 27.

Respectfully submitted,

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